

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.:)	10/797,262
Examiner:)	Richard G. Hutson
Group Art Unit:)	1652
Title of Invention:)	RNA-Dependent DNA Polymerase from
)	<i>Geobacillus stearothermophilus</i>
Filing Date:)	March 10, 2004
Attorney Docket No:)	2826067.000002

Response to Restriction Requirement

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This is in response to the Restriction Requirement mailed September 15, 2006. Applicants respectfully request a one-month extension of time for filing the response. The appropriate small-entity fee under 37 CFR 1.17(a)(1) accompanies this request and response.

Claims 1-16 are pending in the application, and are subject to the present restriction requirement. The Examiner instructed Applicants to elect one of the inventions described by:

- I. Claims 1-4 and 10-14, drawn to a reverse transcriptase polypeptide, classified in class 435, subclass 194.
- II. Claims 5-9, drawn to a polynucleotide encoding a reverse transcriptase polypeptide, classified in class 536, subclass 23.1.
- III. Claims 15-16, drawn to a method for reverse transcription, classified in class 435, subclass 91.1.

Applicants provisionally elect Group I (Claims 1-4 and 10-14) with traverse, and respectfully request reconsideration of the requirement for restriction. The inventions are related as product and process of use. The reverse transcriptase of Group I is an RNA-

dependent DNA polymerase. The claims of Group III are drawn to a method for producing a DNA polynucleotide from an mRNA transcript, a process that requires an RNA-dependent DNA polymerase. As claimed, the process requires the use of an RNA-dependent DNA polymerase as in claim 1. The claims do not describe independent inventions, since the method depends on the use of the polymerase, and, although it would be possible to use a polymerase as an antigenic protein for generating antibodies as the Examiner suggested, the use of an RNA-dependent DNA polymerase in a method of producing DNA from an mRNA transcript is not sufficiently distinct an invention from the isolated polymerase itself that it should place an undue burden on the examiner to perform a search based on the claims of Groups I and III together.

Applicants understand that election of Claims 1-4 and 10-14 of Group I has the effect, under 37 CFR 1.142, of withdrawing the claims of Group II and Group III from further consideration at this time, without prejudice, and subject to reinstatement in the event that the requirement for restriction is withdrawn. Applicants also understand that the subject matter of the non-elected claims may, if necessary, be pursued in a divisional patent application under 35 USC §121, and reserve the right to do so.

Upon a finding that the elected species are allowable, withdrawn process or method claims may be rejoined pursuant to MPEP §821.04 and In re Ochai, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), and the rejoined process claims will be fully

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examined for patentability. Applicants respectfully request rejoinder of the product and process claims at that time, should the Examiner maintain the restriction between Group I and Group III.

Respectfully submitted,

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